

Attorney Docket No. LEAP:129US  
U.S. Patent Application No. 10/698,506  
Reply to Office Action of March 1, 2005  
Date: May 2, 2005

### **Remarks/Arguments**

#### **Amendment to Specification**

The Examiner objected to the disclosure in that in paragraph 0024 of the specification the term "Fig. 47" refers in fact to Fig. 7. Applicant thanks the Examiner for pointing out this error and has amended paragraph 0024 to delete the term Fig. 47 and insert the term Fig. 7 in its place. Applicant respectfully requests reconsideration and removal of the objection to the disclosure.

#### **Objections to Claims 8-9, 14, and 19**

The Examiner objected to Claims 8-9, 14, and 19 for the following informalities:

Claims 8-9 are objected to as lacking a proper antecedent basis for the feature "non-transparent coatings". Applicant has amended claims 8 and 9 to change nontransparent coatings to nontransparent layers. Thus, proper antecedent basis is established with dependency from independent Claim 1 which also claims nontransparent layers. Applicant respectfully requests reconsideration and removal of the objection to Claims 8 and 9.

Claim 14 is objected to as being unclear in the meaning of the phrase "the least of the non-transparent layers". Applicant has amended Claim 14 so that Claim 14 now claims "at least one of the non-transparent layers."

Claim 19 is objected to in that the limitation "coating" should be changed to "layer." Applicant has amended Claim 19 by deleting the term "coating" and inserting the term "layer" in its place. Applicant respectfully requests reconsideration.

#### **Cancellation of Claim 6**

As described below, Applicant has amended Claim 1 to include the limitations of Claim 6. Applicant has cancelled Claim 6.

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The § 103 Rejections of Claims 1-4, 8-9, and 14-18

The examiner rejected Claims 1-4, 8-9, and 14-18 under 35 U.S.C. § 103 (a) as obvious over U.S. Patent No. 5,111,344 to Robinson, et al. ("Robinson" or "the Robinson patent") in view of U.S. Patent No. 5,963,368 to Domanik, et al. ("Domanik" or "the Domanik patent") and U.S. Patent No. 5,598,295 to Olofson ("Olofson" or "the Olofson patent"). Applicant has amended Claims 1 and 15 and respectfully requests reconsideration and passage to allowance of the rejected claims.

Applicant has amended independent Claims 1 and 15 to include the limitation in which the two nontransparent layers are positioned on the same side of the microscope slide and at opposite ends of that same slide and respectfully submits that the combined references fail to render those claims obvious under 35 U.S.C. § 103 (a).

To establish a *prima facie* case of obviousness the reference or references must teach or suggest all limitations of the claim at issue. The teaching or suggestion to make the combined combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant courteously points out that Claims 1 and 15 claim a microscope slide in which printed material is supported on nontransparent layers located on either end of the microscope slide and on the same side of the slide. Applicant submits that the combined Robinson, Domanik and Olofson references fail to disclose this specific claimed invention. Applicant takes note of the Examiner's statement that the Robinson patent does not disclose printed material on the marking surfaces. Further, Domanik only discloses the use of printed material on one end of the slide and does not disclose or suggest the use of a second nontransparent layer as is claimed in Claims 1 and 15.

Finally, Applicant courteously points out that Olofson teaches only one surface designed for marking. Applicant notes that the surface in Olofson only can be scribed and is not designed to support printed material. Olofson teaches a marking system in which two nontransparent coatings of different color are located on the same end and opposite sides of a microscope. The

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Olofson patent teaches that a user scrapes a certain desired symbol into one coating such that the coating material is scraped down to the transparent surface of the microscope slide. This allows the colored coating under the scraped coating to be revealed through the transparent glass thus providing a way for part of a different colored coating through the transparent slide to be seen in the form of the scraped symbol of different color. (See Olofson col. 2, lines 24-25 describing the “overlying/underlying relationship” of the coatings and col. 3, lines 1-12 describing the scribing methods and resulting appearance of the nontransparent coatings.)

It can therefore be seen that the Robinson, Domanik and Olofson patents, either individually or in combination, fail to disclose or suggest all the elements of Applicant's claimed invention, namely a microscope slide with two nontransparent layers located at opposite ends and on the same side of the slide with one transparent layer supporting printed material and the other nontransparent layer supporting a printed representation of the sample held by a claimed third area. As the Examiner notes, Robinson does not disclose the use of printed material on the marking surfaces. Similarly, the Examiner notes that in combination Robinson and Domanik do not disclose one marking surface for printed (machine-readable or human readable) material and one for a printed representation of the specimen. Applicant respectfully submits that Olofson also fails to teach the use of printed material on marking surfaces. In fact, to print on the marking surfaces of the side of Olofson would render impossible the actual practice of the claimed invention of Olofson, namely the scribing of only one surface to create a symbol that may represent a specimen on the slide. Moreover, Olofson, like Robinson and Domanik, fails to disclose printed material, on opposite ends and the same side of the slide. Applicant courteously points out that any suggestion to combine references to render a claim obvious must be come from the references themselves. See *In re Vaeck* above. Thus, Applicant respectfully requests reconsideration and passage to allowance of amended independent Claims 1 and 15.

If an independent claim is nonobvious under 35 U.S.C. § 103 (a), then any claim depending therefrom is nonobvious. Claims 2-4, 8-9 and 14 depend from Claim 1 and Claims 16-18 depend from Claim 15 and thus incorporate all the limitations of those claims,

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respectively. Because, as discussed above, the combined Robinson, Domanik, and Olofson patents fails to render Claims 1 and 15 obvious, they also fail to render Claims 2-4, 8-9, 14, and 16-18 obvious. Applicant respectfully requests the removal of the rejections of Claims 2-4, 8-9, 14, and 16-18 and passage to allowance of those claims.

The § 103 (a) Rejections of Claims 10-13

The Examiner rejected Claim 10-13 under 35 U.S.C. § 103 (a) over Robinson in view of Domanik and Olofson as applied to Claim 1 and further in view of U.S. Patent No. 3,672,745 to Speelman (“Speelman” or “the Speelman patent”). Applicant respectfully traverses these rejections and requests reconsideration.

Claims 10-13 depend from amended Claim 1 and thus incorporate all the elements of that claim. Applicant notes the Speelman patent is directed to different edge configurations of microscope slides and does not provide any teaching for marking slides at all, let alone marking slides with printed material on two different nontransparent layers. As noted above, because Robinson, Domanik and Olofson fail to disclose all the limitations of amended Claim 1 they fail, by themselves and in combination with Speelman, to disclose all the limitations of dependent Claims 10-13. Thus Applicant respectfully requests reconsideration and passage to allowance of Claims 10-13.

The § 103 (a) Rejections of Claims 1, 6, and 19-22

The Examiner rejected Claims 1, 6, and 19-22 under 35 U.S.C. § 103 (a) as obvious over Robinson in view of Domanik and Olofson and further in view of U.S. Patent No. 5,638,459 to Rosenlof, et al. (“Rosenlof” or “the Rosenlof patent”). Applicant has cancelled Claim 6 thereby rendering the rejection of that claim moot. Applicant has amended independent Claims 1 and 19 and respectfully traverses the rejections of those claims as well as the rejections of Claims 20-22 which depend from Claim 19.

Applicant respectfully takes note of the arguments above regarding amended Claim 1 that

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demonstrate that the combined references of Robinson, Domanik and Olofson fail to render Claim 1 obvious. Applicant courteously notes that the Rosenlof patent is directed towards a method and apparatus of detecting a microscope slide cover slip. Although, as noted by the Examiner, Rosenlof does disclose the use of a label on a microscope slide, similar to Robinson, Domanik, and Olofson, the Rosenlof patent fails to disclose printed material on opposite ends and the same side of a microscope slide as well as two nontransparent layers. Consequently, the combined references of Robinson, Domanik, Olofson and Rosenlof fail to teach or disclose each limitation of amended Claim 1.

For the same reasons, the combined references fail to render amended Claim 19 obvious in that they fail together to disclose all the limitations of that claim, specifically support of printed material on one nontransparent layer and a printed sticker on a second nontransparent layer on a slide in which the nontransparent layers are on opposite ends and on the same side of the slide. Therefore, Applicant respectfully requests reconsideration of the rejections of Claims 1 and 19 and passage to allowance of those claims.

If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. Claims 20-22 depend from amended Claim 19 and thus incorporate all the limitations of that claim. Because, as discussed above, the Robinson, Domanik, Olofson, and Rosenlof patents fail to render Claim 19 obvious, they also fail to render obvious dependent Claims 20-22. Applicant respectfully requests the removal of the rejections of Claims 20-22 and passage to allowance of those claims.

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**Conclusion**

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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